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APR 18 2012
TC 1700

RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions:

- I. Group I, claims 31-55, drawn to a method for producing chill rolls.
- II. Group II, claims 56-84, drawn to an iron alloy composition for chill rolls.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect, with traverse the invention set forth in Group II, claims 56-84.

Applicants submit that a restriction is inappropriate in this case.

According to the Office Action, the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they allegedly lack the same or corresponding special technical features for the reason that the special technical feature (iron alloy used for chill rolls) is allegedly known. In this regard, the Office Action merely makes reference to the search report, without any explanation as to which passage(s) of which document(s) cited in the search report is (are) considered to anticipate the special technical feature referred to in the Office Action. Moreover, the Office Action does not indicate what exactly the Examiner considers to constitute said “iron alloy used for chill rolls”, which is a further reason why Applicants are not even in a position to comment on the Examiner’s allegations.

It is respectfully submitted that for the above reasons alone, the Restriction requirement is inappropriate and should be withdrawn.

Furthermore, in MPEP Chapter 800, the Office sets forth its policy by which examiners are guided in requiring restriction under 35 U.S.C. §121. Section 803 states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Although Groups I and II differ in that Group I is directed to a method for producing chill rolls and Group II is directed to an iron alloy composition for chill rolls, the underlying concepts are quite similar. Thus, a search for the method of Group I should cover areas relevant to the alloy composition of Group II. In other words, for examination purposes, if a search area were relevant to the method of Group I, it would also be relevant to the alloy composition of Group II. Conversely, if a search area were relevant to Group II, it would be relevant to Group I.

Therefore, as a practical matter, the searches for the Groups should significantly overlap. Thus, the search burden would not be serious.

Therefore, also in view of the lack of a serious burden, Applicants respectfully request that the Restriction requirement be reconsidered and withdrawn.

P21259.A04



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APR 18 2003
TC 8700

If the Examiner has any questions concerning this matter or the application, the undersigned can be contacted at the below-listed telephone number.

Respectfully submitted,
B. FEISTRITZER et al.

Neil F. Greenblum

Reg. No. 28,394

Reg. No.
31,296

February 21, 2003
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191